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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BODDIE, WILLIAM

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/691,272	Applicant(s) CHEON ET AL.	
	Examiner WILLIAM L. BODDIE	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12, 17-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12, 17-23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In an amendment dated, February 22nd, 2008, the Applicant amended claims 23 and 26, cancelled claims 24-25, and added new claim 29. Currently claims 9-12, and 17-23 and 26-29 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22nd 2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 23 and 26-29 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's arguments with respect to claims 9-12, 17-22 have been fully considered but are not persuasive.

5. On pages 8-10 of the Remarks, the Applicants traverse the rejections of claims 18, and 21-22. The Applicants first argue that the light guide of Bohn does not introduce external lights into the case.

The Examiner must respectfully disagree. As was stated in the previous office action the Examiner is aware that Bohn's invention is aimed to provide illumination outside of the case via the light guide. However, it is seen as inherent that any ambient

light incident on the protruding lenses of Bohn would be introduced into case. In other words, while the lenses of Bohn are used to guide light out of the case, it is seen as an inherent principle of optics that light propagating in a reverse direction (in towards the lens of Bohn) will travel the same path as light output by Bohn. It is this inherent reverse propagation that satisfies the current claim limitations. The Applicant appears to be arguing that sunlight will not be introduced into a room with a window if a light source located within the room is also transmitting light in an opposite direction of the window.

6. On page 9 of the Remarks, the Applicant argues again that Bohn does not teach a light guide. Applicants argue that Bohn's lenses, while protruded, do not function as light guides.

Again the Examiner must respectfully disagree. The specification piece cited by Applicants discloses that the lenses of Bohn do indeed function as light guides. In col. 4, lines 59-67, Bohn states, "the lenses may be optical devices that disperse light." Bohn clearly states that the lenses "disperse light." This is seen as a clear example of guiding light and sufficient to call the lenses "light guides" as currently claimed.

7. On page 10, the Applicants also argue that there is no motivation to combine Bohn and Son. The Examiner must disagree, as stated in the previous office action the combination would provide the benefit of support for additional structures in the cursor control device (Son; col. 3, lines 41-43).

8. On pages 10-11 of the Remarks, the Applicants traverse the rejection of claims 19-20 arguing that Bohn and Son teach away from Hines. Specifically the Applicants

argue that Hines' light guide is placed at a side wall and Bohn and Son's light guides are placed at other locations, and due to this placement this is seen as teaching away.

This incorrect example of teaching away was seen throughout the Remarks. The Applicants are directed to section 2141.02.VI which specifically discusses teaching away arguments. The pertinent sentence in the instant case reads as follows:

the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....

In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). The mere placement of the light guides at different positions is not seen as criticizing, discrediting or otherwise discouraging the solution claimed.

9. On pages 11-14 of the Remarks, the Applicants traverse the rejection of claim 9-10, 17 and 11-12.

The Applicants first argue that Perret does not teach a light concentrating plate that reflects external light. The Examiner must respectfully disagree.

The current wording of the claim, examined under the broadest reasonable definitions, allows a fluorescent light bulb to be deemed external to at least the optical wave guide and also the light concentrating plate. It should additionally be noted that Applicants within their own specification has defined external light to include "typical electric illumination." (p. 8, line 1).

10. On page 12, the Applicants again propose a false "teaching away" argument. Applicants are directed to the above discussion.

11. On pages 12-13 of the Remarks, the Applicants argue that Rai teaches a light concentrating plate that *reflects* external light. The Examiner must strenuously disagree. It is unclear how Rai could be any clearer that the incoming light is reflected off of the concentrating plate 44 in fig. 6. There is a clear reflection directly off of the surface of 44.

12. On page 13 of the Remarks, the Applicants form a more appropriate teaching away argument, describing a section of Rai which states that both external and artificial light sources are necessary. The Applicants argue this teaches away from the claimed invention as all that is required in the invention is an external light source. However, this argument is not persuasive, as the claim is not currently limited to *only* external illumination.

13. On page 13 the Applicants argue that there is no motivation for combining the two references. The Examiner must disagree, as stated in the previous office action the combination would provide the benefit of uniform brightness, preventing light leakage, decreasing the dimensions of the case (Rai; col. 6, lines 37-39), and most importantly decreasing power consumption by a significant amount (Rai; col. 1, lines 25-29).

14. On page 14, the Applicants argue that claims 11-12 should be allowably simply by the nature of their dependence upon the above discussed base claims. As shown above these claims are seen as properly rejected and are thus maintained in the below office action.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 9-10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perret, Jr. et al. (US 5,736,686) in view of Rai et al. (US 6,369,866).

With respect to claim 9, Perret, Jr. discloses, an optical cursor control device (graphic digitizing tablet) having a light concentrating pad (fig. 1) and an optical pointing device moved on the light concentrating pad by an operator (col. 1, lines 14-19), the light concentrating pad comprising:

an optical wave guide (14 in fig. 1);

a lower reflecting plate (15 in fig. 1; col. 3, line 63) attached to a bottom of the optical wave guide for upwardly reflecting light introduced into the optical wave guide; and

an upper transparent plate (49, 56 in fig. 1) attached to a top of the optical wave guide for passing the light reflected from the lower reflecting plate.

side reflecting plates (52 in fig. 1) attached to a portion of sides of the optical wave guide for reflecting the light in the optical wave guide (col. 5, lines 12-14 discloses that the edge is coated with aluminized mylar thus creating a light concentrating plate (note the rays around 48 in fig. 1)); and

a light concentrating plate (47 in fig. 1), wherein the light concentrating plate reflects external light (58, 40 in fig. 1) into the optical wave guide through another portion of the sides of the optical wave guide (col. 14, lines 24-30; clear from fig. 1).

Perret, Jr. does not expressly disclose that the light concentrating plate is attached to an edge of the lower reflecting plate and separated from the upper transparent plate.

Rai discloses a backlight lighting apparatus (fig. 6; for example) comprising, a light concentrating plate (44 in fig. 6) attached to an edge of a lower reflecting plate (40 in fig. 6) and separated from an upper transparent plate (10 in fig. 6), wherein the light concentrating plate reflects external light into an optical wave guide (20 in fig. 6; clear from fig. 6; col. 6, lines 6-29).

Rai and Perret, Jr. are analogous art because they are both from the same field of endeavor namely backlighting systems.

At the time of the invention it would have been obvious to one of ordinary skill in the art to attach the light concentrating plate of Perret, Jr. to an edge of the lower reflecting plate and separate from the upper transparent plate as taught by Rai.

The motivation for doing so would have been to achieve uniform brightness, prevent light leakage, decrease the dimensions of the case (Rai; col. 6, lines 37-39), and most importantly decrease power consumption by a significant amount (Rai; col. 1, lines 25-29).

With respect to claim 10, Rai and Perret, Jr. disclose, the optical cursor control device according to claim 9 (see above).

Perret, Jr. further discloses, wherein the upper transparent plate includes regular patterns drawn on a surface thereof (col. 4, lines 42-46).

With respect to claim 17, Rai and Perret, Jr. disclose, the optical cursor control device according to claim 9 (see above).

Perret, Jr. further discloses, a light source (16 in fig. 1) emitting a light toward the light concentrating plate, wherein the light concentrating plate reflects the light from the light source into the optical wave guide (clear from fig. 1).

It should be noted that Rai also discloses a light source (50 in fig. 6; and ambient light sources in fig. 6), which are reflected by the light concentrating plate.

17. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perret, Jr. et al. (US 5,736,686) in view of Rai et al. (US 6,369,866) and further in view of Lyon (US 4,521,772).

With respect to claim 11, Rai and Perret, Jr. disclose, the optical cursor control device according to claim 9 (see above).

Neither Rai nor Perret, Jr. expressly disclose further detail regarding the optical pointing device.

Lyon discloses, an optical pointing device comprises;
a case (108 in fig. 22) including a lower panel, the lower panel having an opening (clear from fig. 22);
an optical sensor (120 in fig. 22) mounted inside the case for sensing reflected light introduced into the case through the opening (fig. 22); and

a printed circuit board (110 and 112 in fig. 22) for processing a signal outputted from the optical sensor to generate an output signal that corresponds to a position of the case.

Lyon, Rai and Perret, Jr. are analogous art because they are all from the same field of endeavor namely, backlight control systems.

At the time of the invention it would have been obvious to one of ordinary skill in the art to construct the optical pointing device of Rai and Perret, Jr. as taught by Lyon.

The motivation for doing so would have been due to its high reliability over long periods of time (Lyon; col. 2, lines 20-24).

With respect to claim 12, Lyon, Rai and Perret, Jr. disclose, the optical cursor control device according to claim 11 (see above).

Lyon further discloses, wherein the optical pointing device further comprises:
a switch module disposed on the printed circuit board (114, 115 in fig. 22); and
a button disposed at the top surface of the case to turn on or off the switch module (116 in fig. 22).

18. Claims 18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US 6,618,038) in view of Son (US 6,741,234).

With respect to claim 18, Bohn discloses, an optical cursor control device (fig. 1 for example) including a worktable (140 in fig. 7) and an optical pointing device (500) moved on the worktable by an operator, the optical pointing device comprising:
a case (504 in fig. 7);

a light guide (108 in fig. 7) disposed at a sidewall of the case (clear from fig. 7), introducing external lights into the case and including a protrusion outwardly protruded from the case (col. 4, lines 59-60), the light guide directly accepting the external lights through the protrusion to obliquely irradiate lights penetrating the light guide (note the ray traces in fig. 7) onto a surface of the worktable through an opening (507 in fig. 7) formed in a lower panel of the case (506 in fig. 7);

an optical sensor (511 in fig. 7) disposed in the case and over the opening to detect lights reflecting from the surface of the worktable (clear from fig. 7).

While Bohn's invention is aimed to providing illumination out of the case, it is seen as inherent that external light incident on the lenses of Bohn would satisfy the limitations of the claims as currently written.

Bohn does not expressly disclose, a printed circuit board.

Son discloses, an optical pointing device (fig. 7) comprising; a printed circuit board (23 in fig. 7) with electronic parts (27 in fig. 7) processing an output signal of an optical sensor (25, 27 in fig. 7) to generate an output signal that corresponds to a position of the case (note the output wiring in fig. 7).

Bohn and Son are analogous art because they are from the same field of endeavor namely, optical cursor control devices.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the printed circuit board of Son in the cursor control device of Bohn.

The motivation for doing so would have been to provide support for additional structures in the cursor control device (Son; col. 3, lines 41-43).

With respect to claim 21, Son and Bohn expressly disclose, the optical cursor control device according to claim 18 (see above).

Bohn further discloses, comprising a light emitting device (520 in fig. 7) installed in the case, wherein the light emitting device is automatically or manually turned on (col. 9, lines 46-50; for example) and the lights from the light emitting device are irradiated onto the surface of the work table through the opening (clear from fig. 7).

With respect to claim 22, Son and Bohn expressly disclose, the optical cursor control device according to claim 18 (see above).

Son further discloses, a switch module (22 in fig. 7) mounted on the printed circuit board (23 in fig. 7); and a button (21 in fig. 7) disposed on a top of the case to turn on or turn off the switch module (clear from fig. 7).

19. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (US 6,618,038) in view of Son (US 6,741,234) and further in view of Hines (US 6,111,563).

With respect to claim 19, Son and Bohn expressly disclose, the optical cursor control device according to claim 18 (see above).

Bohn further discloses, irradiating the lights penetrating the protrusion onto the surface of the worktable (note the ray traces from 108 in fig. 7).

Neither Son nor Bohn expressly disclose, wherein the light guide includes a light concentrating surface and an illuminating surface.

Hines discloses, an optical cursor control device (fig. 5), wherein a light guide (22 in fig. 5) includes a light concentrating surface (outer surface of lens 22) located at a

protrusion to directly accept external lights (note the rays in fig. 5) and an illuminating surface (inner surface of lens 22) located opposite the protrusion (col. 3, lines 58-67).

Hines, Son and Bohn are analogous art because they are all from the same field of endeavor namely, optical cursor control devices.

At the time of the invention it would have been obvious to one of ordinary skill in the art to replace the lens of the Son and Bohn device with those taught by Hines.

The motivation for doing so would have been their optically wide angle of ray transmission (Hines; col. 7, lines 46-55).

With respect to claim 20, Hines, Son and Bohn expressly disclose, the optical cursor control device according to claim 19 (see above).

Hines further discloses, wherein the illuminating surface has an area smaller than that of the light concentrating surface (clear from fig. 5, that the inner rays of Hines are found on a much smaller surface area than those on the outside of the housing).

20. Claims 23 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brogårdh et al. (US 4,475,240) in view of Mumford (US 6,377,249).

With respect to claim 23, Brogårdh discloses, an optical cursor control device (fig. 9) having a worktable (3 in fig. 9) and an optical pointing device (fig. 9) moved on the worktable by an operator, the optical pointing device comprising:

- a case (33 in fig. 4a; for example);

- an optical sensor disposed in the case (129 in fig. 9; for example);

- a light guide (36, 121 in fig. 9) that comprises a first surface (bottom of 36 in fig. 9) that accepts light reflecting from a surface of a worktable (3 in fig. 9) adjacent to the

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case and a second surface (top of 121 in fig. 9) that introduces the light penetrating the light guide onto an optical sensor (129 in fig. 9); the light guide being disposed at a sidewall of the case (clear from fig. 4b) for introducing the light reflecting from the surface of the worktables into the case; and

a printed circuit board (140 in fig. 9; col. 7, lines 16-23) with electronic parts (141-144 in fig. 9; and fig. 10) processing an output signal of the optical sensor to generate an output signal that corresponds to a position of the case (col. 7, lines 24-66).

Brogårdh does not expressly disclose that the light guide includes a protrusion outwardly protruded from the case.

Mumford discloses an optical cursor control device having a light guide including a protrusion outwardly protruded from the case (7 in fig. 20).

Mumford and Brogårdh are analogous art because they are both from the same field of endeavor namely fiber optic light guide pens.

At the time of the invention it would have been obvious to one of ordinary skill in the art to protrude the light guide of Brogårdh as taught by Mumford for the well-known benefit of increased light introduction and field of view.

With respect to claim 26, Brogårdh and Mumford disclose, the optical cursor control device according to claim 23 (see above).

Brogårdh does not expressly disclose including light concentrators.

Mumford discloses, wherein the light guide further comprises light concentrators disposed at the first (101 in fig. 10) and second surfaces (note the convex lens located

on the detectors 106 in fig. 10), and the light concentrators increase the intensities of the lights passing through the light concentrators (col. 12, lines 20-22).

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the light concentrators of Mumford on the light guide of Brogårdh for the benefit of increased light intensity (Mumford; col. 12, lines 20-22).

With respect to claim 27, Brogårdh and Mumford disclose, the optical cursor control device according to claim 26 (see above).

Brogårdh, when combined with Mumford, further discloses wherein the light concentrators are convex lenses (Mumford; clear from fig. 10).

With respect to claim 28, Brogårdh and Mumford disclose, the optical cursor control device according to claim 23 (see above).

Brogårdh does not expressly disclose a button.

Mumford discloses, a switch module (236 in fig. 24) mounted on the printed circuit board; and a button (116 in fig. 20) disposed on a top of the case to turn on or off the switch module.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the button and switch module of Mumford on the circuit board of Brogårdh for the well-known benefit of increased user functionality.

With respect to claim 29, Brogårdh and Mumford disclose, the optical cursor control device according to claim 23 (see above).

Brogårdh further discloses wherein the first and second surfaces are parallel to each other (clear from fig. 9).

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM L. BODDIE whose telephone number is (571)272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sumati Lefkowitz/
Supervisory Patent Examiner, Art Unit 2629

/W. L. B./
Examiner, Art Unit 2629
3/24/08